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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/001,580  | 11/01/2001  | Yoon Kean Wong       | 035451-0166 (3704.Palm) | 2720             |
| 26371 7590 07/15/2009<br>FOLEY & LARDNER LLP<br>777 EAST WISCONSIN AVENUE<br>MILWAUKEE, WI 53202-5306 |             |                      |                         |                  |
| EXAMINER  |             |                      |                         |                  |
| ELISCA, PIERRE E  |             |                      |                         |                  |
| ART UNIT  |             | PAPER NUMBER         |                         |                  |
| 3621  |             |                      |                         |                  |
| MAIL DATE   |             | DELIVERY MODE        |                         |                  |
| 07/15/2009  |             | PAPER                |                         |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/001,580

**Applicant(s)**

WONG ET AL.

**Examiner**

Pierre E. Elisca

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/19/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-37, 39-46, 48-52, 54 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-37, 39-46, 48-52, 54 and 56-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is in response to Applicant's amendment/RCE filed on 06/19/2009.
2. Claims 30-37, 39-46, 48-52, 54 and 56-59 are currently pending and have been examined.

***Claim Objections***

3. Claims 30-37, 39-46, 48-52, 54 and 56-59 are objected to for usage of the functional language "configured to". It is believed that Applicants intend "configured to" to mean "programmed to" since "configured to" is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing "configured to" to "programmed to" where a positive recitation is desired. See Also MPEP 2106.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30-54 and 56-59 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ham, Byung I1 (U.S. Pat. No. 6,292,147) and Kakahara et al (U.S. Pat. No. 6,959,282) **in view of Partovi, Hadi et al (U.S. Pat. No. 7,376,586).**

As per claims 30-33 and 35-38 Ham substantially discloses a variety of portable devices that have been proposed for incorporated GPS receiver therein, and are becoming increasingly popular due to the availability of low cost GPS receivers and a wide variety of GPS applications. For example, a GPS receiver may be incorporated into a portable device (e.g., cellular phone, handheld GPS navigation system to provide various functionality such as to determine its location, the system comprising:

A handheld computer comprising a location circuit configured to provide location data based on the location of the handheld computer and wireless transceiver configured to provide wireless communication (see., abstract, figs 2-4, col 1, lines 23-34, col 2, lines 43-60, col 3, lines 9-67).

Ham fails to explicitly disclose wherein said the pricing system configured to price or sell the insurance product (or company), based on the data (or based on the location of the object ).

However, Kakahara discloses **a toll (or price)** collection arrangement based on the position and travel of a vehicle. A charging information for the vehicle is created based on the position of a moving body as well as buffer areas and map information, then even if there are detection errors in the detection of the position of the vehicle

(see., abstract, col 2, lines 42-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the navigation system for cars of Ham by including an insurance product or company that is connected to the navigation system as taught by Kakihara Murakami since it is an alternate means for acquiring insurance information about the location of a car/object.

It is to be noted that Ham and Kakihara fail to explicitly disclose Applicant's newly added limitation of "identifying product associated with the user identifier". Partovi discloses a method/system of identifying product associated with the user identifier (see., abstract, col 1-col 23, col 24, lines 46-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Ham and Kakihara by including the limitation detailed above as taught by Partovi because this would allow insurance company to identify the location of a user.

As per claim 34 Ham discloses a car (or object) navigation system that is adapted to be installed on a car for estimating a location of the car or object, detecting occurrence of an accident and performing communication data, a location unit for generating car location (see., abstract, figs 2-4, col 1, lines 23-34, col 2, lines 43-60, col 3, lines 9-67).

As per claims 39-41, 43-54 and 56-59 Ham substantially discloses a variety of portable devices that have been proposed for incorporated

**GPS receiver therein, and are becoming increasingly popular due to the availability of low cost GPS receivers and a wide variety of GPS applications. For example, a GPS receiver may be incorporated into a portable device (e.g., cellular phone, handheld GPS navigation system to provide various functionality such as to determine its location, the system comprising:**

A handheld computer comprising a location circuit configured to provide location data based on the location of the handheld computer and wireless transceiver configured to provide wireless communication (see., abstract, figs 2-4, col 1, lines 23-34, col 2, lines 43-60, col 3, lines 9-67).

Ham fails to explicitly disclose wherein said the pricing method configured to price or sell the insurance product (or company), based on the data (or based on the location of the object or car).

However, Kakiyara discloses **a toll (or price)** collection arrangement based on the position and travel of a vehicle. A charging information for the vehicle is created based on the position of a moving body as well as buffer areas and map information, then even if there are detection errors in the detection of the position of the vehicle (see., abstract, col 2, lines 42-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the navigation system for cars of Ham by including an insurance product or company that is connected to the navigation system as taught by Kakiyara Murakami since it is an alternate means for acquiring insurance information about the location of a car/object.

It is to be noted that Ham and Kakihara fail to explicitly disclose Applicant's newly added limitation of "identifying product associated with the user identifier". Partovi discloses a method/system of identifying product associated with the user identifier (see., abstract, col 1-col 23, col 24, lines 46-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Ham and Kakihara by including the limitation detailed above as taught by Partovi because this would allow insurance company to identify the location of a user.

**As per claim 42 Ham discloses a car (or object) navigation method that is adapted to be installed on a car for estimating a location of the car or object, detecting occurrence of an accident and performing communication data, a location unit for generating car location ( see., abstract, figs 2-4, col 1, lines 23-34, col 2, lines 43-60, col 3, lines 9-67).**

### ***RESPONSE TO ARGUMENTS***

6. Applicant's arguments with respect to claims 30-37, 39-46, 48-52, 54 and 56-59 have been fully considered but they are moot in view of new ground (s) of rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00. Hotelers.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Pierre E. Elisca/  
Primary Examiner, Art Unit 3621